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| 10/615,249  | 07/08/2003  | Edward L. Rapp       | 02280.003720.              | 8220             |
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| FITZPATRICK CELLA HARPER & SCINTO<br>30 ROCKEFELLER PLAZA<br>NEW YORK, NY 10112 |             |                      |                            |                  |
|   |             |                      | EXAMINER<br>PRATT, HELEN F |                  |
|   |             |                      | ART UNIT<br>1761           | PAPER NUMBER     |

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/615,249

Applicant(s)

RAPP ET AL.

Examiner

Helen F. Pratt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-8 and 10-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-8 and 10-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Double Patenting***

***The terminal disclaimer has been received and approved.***

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-8, 10-13, 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. (4,055,669) in view of Froseth et al. (6,592,915) and Rombauer et al., p. 708.

The hedonic score as in claim 1 of at least 5.2 is shown because the composition of Kelly can be a bar and does provide energy and nothing is seen that the bar would not have the claimed hedonic value (abstract).

A confidence level of 60% is seen to have been shown as it would inherently have this value since the product is an energy bar (abstract) as in claim 2 and acceptability since it is an energy bar and would inherently have this consumer acceptability as in claim 3 absent a showing to the contrary.

Kelly et al. disclose making a binder composition of fat, sodium caseinate (protein) and milk solids, and sugar to make a homogenous mixture, to which sensitive

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components such as vitamins and minerals, emulsifiers and colors are added at a temperature, and within a degree of mixing in a mixer that will not crush the particles as in claims 4, and 8 (col. 5, lines 54-66, col. 6, lines 29-60). The reference discloses that the blending is a critical operation that was done at temperatures from 100 to 140 F. and limited to the extent necessary to wet the added cereal particles.

The protein powder is sodium caseinate which has been rolled with other ingredients to the size of 50 microns as in claims 6 and 10. The protein powders would have had to have been about the claimed caseinate size of at least 35 microns since all the ingredients are 50 microns (col. 6, lines 38-60).

This composition would make a chewy energy bar with an acceptability of at least 4.9 due to the use of the claimed ingredients as in claim 7 (col. 6, lines 29-60).

Claims 1-13, 18-20 also require that the compositions contain particular amounts of proteins, fat, and carbohydrates in a bar containing particular amounts of calories, particular serving size and moisture content. However, particular amounts, moisture content, calories and serving sizes are seen to have been within the skill of the ordinary worker. Attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no

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one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. In re Benjamin D. White, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; In re Mason et al., 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221. Even if the claimed ingredients are not exactly as claimed, it would have been obvious to vary amounts and ingredients as in using various recipes as the function of each ingredient is known (Froseth et al. (col. 26, lines 49-56). Therefore, it would have been obvious to use particular amounts of ingredients, calories, serving sizes and moisture content in the claimed compositions.

The independent claims have also been amended to require the particular ingredients are selected from the corresponding Markush grouping. However, the ingredients in each of the group seem to include any and all relevant types of protein fats and proteins and as in In re Levin above, nothing new is seen in using known ingredients for their known functions.

Claims 1 and 2 and other independent claims and dependent claims also have been amended to require slightly different amounts of ingredients. However, it is seen that it would have been within the skill of the ordinary worker to use particular amounts of known ingredients, absent a showing of unexpected results using the claimed amounts.

Therefore, it would have been obvious to use known ingredients in various amounts to make an energy bar and to vary known ingredients as shown in the reference to make it acceptable in taste.

Further, Froseth et al. disclose as in claim 4 adding sensitive food ingredients to a binder (abstract and Fig. 5A and col. 4, lines 36-44, col. 14, lines 61-70). The reference discloses that flavors are added last to avoid adverse affects from too much heat (col. 13, lines 9-11). Nothing is seen that the degree of mixing affects the sensitive components. The reference is aware that various process parameters such as temperature affects the ingredients. The velocity of mixing is well known to affect ingredients, hence the settings on mixers of slow to fast. Therefore, it would have been obvious to make a composition in which the temperature and shear were controlled.

Claim 11 further requires that an energy bar matrix is made by mixing a solid component into a syrup to make a energy bar matrix, and then mixing the matrix with a fat-carbohydrate matrix. Rombauer et al. disclose, in the recipe Pfeffernusse, an energy matrix made of corn syrup which is combined with a solid component which is grated lemon rind, which is mixed into a fat-carbohydrate matrix, which is butter and sugar (page 708). The energy bar is seen to be lubricious since it contains fat. Also, as in In re Levin: This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a

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patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. In re Benjamin D. White, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; In re Mason et al., 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221. Therefore, it would have been obvious to make a composition with matrixes as shown by Rombauer as required in the composition of Kelly.

Claim 12 further requires adding well-known types of candies, which contain fat and carbohydrates into the energy bar. However, nothing new is seen in adding a fat-carbohydrate mixture as in chocolate chip cookies or bars, which contain chocolate chips or in cookies which contain the large chocolate kiss (Rombauer, page 705, chocolate-chip drop cookies). Therefore, it would have been obvious to add candy inclusions into an energy bar matrix for their known function of adding more fat and sugar in a tasteful formulation.

Claim 13 further requires the addition of fortification ingredients. Kelly et al. disclose the addition of vitamins and minerals to the binder of that composition (col. 5, lines 40-51). Therefore, it would have been obvious to fortify as shown by Kelly et al.

The limitations of claim 18 have been disclosed above by the above combination of references which would give the hedonic gains as in claims 19 and 20. Therefore, it would have been obvious to make the composition by processing sensitive ingredients as shown by Kelly et al., and strategically positioning functional ingredients as shown by Kelly and to use a fat carbohydrate matrix as disclosed by Rombauer et al. in the

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process of Kelly et al. if one wanted to add more fat as shown by adding the candy inclusions of Rombauer (chocolate chips) or the fat carbohydrate matrix as shown on page 708 of Rombauer et al.

Claims 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Rombauer et al. (Joy of Cooking, page 708).

Claims 14 further and 16 require that an energy bar matrix is made by mixing a solid component into a syrup to make a energy bar matrix, and then mixing the matrix with a fat-carbohydrate matrix. Rombauer et al. disclose, in the recipe Pfeffernusse, an energy matrix made of corn syrup which is combined with a solid component, grated lemon rind, which is mixed into a fat-carbohydrate matrix ( butter and sugar )(page 708). The composition is considered to have a lubricious mouthfeel since the claimed ingredients are used.

. Claims 14-17 further require particular amounts of ingredients, calories and moisture content and serving size. However, In re Levin applies as above. Therefore, it would have been obvious to use particular amounts, calories and moisture contents and serving size to make an energy bar. The composition is considered to have the claimed hedonic score as in claims 15 and 17 as the composition has been shown

Claim 21 further requires a particular fat to carbohydrate ratio. However, this ratio is so large, that it is seen that it would have been within the skill of the ordinary worker to vary the ratio depending on whether a low-calorie or a less sweet bar is required. The further ingredients are well known food ingredients used in making food bars, and nothing unexpected as in In re Levin is seen in their use. Therefore, it would



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have been obvious to vary the amount of fat to carbohydrate ratio, in order to make a good tasting bar, or a low fat or sugar bar.

Claim 22 further requires a particular moisture content. No moisture content is found for Kelly. However, as no water is added to the composition and the composition contains the claimed ingredients, it is seen that the moisture content would have been within the claimed amount in Kelly. Froseth et al. disclose a  $A_w$  of from 0.35 to 0.55 which is seen to have been within the claimed range (col. 2, lines 60-70). Therefore, it would have been obvious to make a bar with the claimed moisture content.

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above combined references as applied to claims 1-22 above, and further in view of Avera (3,615,590).

Avera discloses a nut butter with a particle size of 96 % which would pass through a US sieve of 200 mesh size which is 75 microns, which leaves less than 10% having a particle size of less than 75 microns (col. 2, lines 65-70). No patentable distinction is seen at this time in the sizes of less than 10% as most of the particle sizes are within the claimed range. Therefore, it would have been obvious to use a nut butter which contains plant protein in near the claimed amounts in the process of the combined references because the reference discloses that protein is known in the claimed amounts.

#### ARGUMENTS

Applicant's arguments filed 5-11-06 have been fully considered but they are not persuasive. Applicants argue that the composition as noted in the first Declaration of Rapp is to a good tasting energy bar, which is made by controlling certain factors such as temperature and shear, particle size of protein and a fat-carbohydrate matrix. As to temperature and shear, these are process limitations in a composition claim or in product by process claims. Applicants in their Declaration have not compared the closest prior art, but high and low shear. As to the 11 g. of fat as opposed to 8 g of fat, nothing unobvious is seen in using 2 grams less of fat, as it is known that fat contains a lot of calories, and to reduce the fat, is to reduce calories. As in In re Levin, no coaction of ingredients is seen to produce anything new.

As to the particle size of protein, nothing has been shown that the particle size of protein as in Kelly is not within the claimed size range. The reference discloses milk protein, i. e. sodium caseinate and dry milk which contain protein. Applicants' example 5 shows that it is the particle size of the protein is important. The burden is on applicants to show that the particle size of protein in Kelly would not have been within the claimed size because the patent office does not have the facilities to do so. Such a showing would indicate allowable subject matter if such could be determined to be in the 16 micron size range as in applicants Ex. 4.

As to the carbohydrate fat matrix, this is not found in the composition claims, but in claim 14 which is a product by process claim in which the process is not given weight absent a showing of unexpected results. The use of a fat-carbohydrate mixture is so

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well known, that it barely needs a reference. This is known as "creaming", i. e. blending sugar and fat together, before adding other ingredients.

Applicants cite various differences in amounts, however, the references were used for what they teach as disclosed in the office action.

No temperature controlling of the temperature is seen in claim 14, but is seen in claim 18. But no actual temperature or shear is cited or what process sensitive ingredients are required that would have been affected. Certainly, one knows that temperature affects vitamins, such as vitamin C, and it would have been within the skill of the ordinary worker to process ingredients so they taste good.

As to claims 22-24, the references are used for what was disclosed in the office action.

As to secondary considerations , the success of the energy bar is noted. However, carefully combining ingredients and the use of known ingredients is seen as obvious. It is known that various products take years to develop. Certainly, good tasting candy bars are known. It cannot be determined at this time whether the reference to Kelly discloses the proper protein particle size. A showing by Applicant would help to determine this.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 571-272-1404. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hp 6-5-06

  
HELEN PRATT  
PRIMARY EXAMINER